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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,437	11/16/2000	Lynn Watson	5087-21	5708

20575 7590 04/26/2005

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EXAMINER

STEVENS, THOMAS H

ART UNIT PAPER NUMBER

2123

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/715,437

Applicant(s)

WATSON ET AL.

Examiner

Thomas H. Stevens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-20 were examined.

***Section I Response to Applicant's Arguments (Post Advisory Action)***

***35 USC § 112 (1<sup>st</sup>)***

2. Applicant's amendments didn't overcome rejection. Rejection stands.

***35 USC § 112 (2<sup>nd</sup>)***

3. Applicants are thanked for addressing this issue. Based on applicants' response, rejections are withdrawn.

***35 USC § 102(e)***

4. Applicants are thanked for addressing this issue. Applicants' arguments are persuasive; rejection is withdrawn.

***35 USC § 103***

5. Applicants are thanked for addressing this issue. Applicants' arguments are persuasive; however, examiner has found new art in light of amended claims.

***Section II Rejections (Third Office Action)***

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and figures disclose general facts with minimal explanation of how the invention works.

***Claim Rejections - 35 USC § 103***

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8, 10-14 and 20 are rejected under 35 U.S.C. 103 (a) as obvious by Shaheen et al. (U.S. Patent 5,893,920 (1999)), in view of Lew et al., (U.S. Patent (6,385,567 (2002))).

12. As to claim 1, Shaheen et al. teaches a system and method for cache management in mobile user file systems (title) by way of a first computer system which disables from said second file system when necessary (columns 8-9, lines 67-68 and 1-8, respectively); but doesn't teach emulation. Lew et al. teaches selecting a set of instructions automatically wherein the set of instructions is made by the host computer (column 4, lines 31-36).

It would have been obvious, at the time of invention, to one of ordinary skill in the art to modify Shaheen et al. by Lew et al., to preserve files with updates that need to be synchronized back to the server (Shaheen: column 3, lines 36-39) during the emulation process.

11. As to Claim 1, Shaheen teaches:

a. allow the memory to be disconnected from first computer (Shaheen: columns 8-9, lines 66-67, 1-8, respectively)

12. As to Claim 1, Lew teaches:

a. a memory operable to store instructions, wherein the instructions include at least one set

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of instructions for an emulated operating environment (column 3, line 66-column 4, line 1, column 4, lines 18-26, 33-36) wherein the memory is either the memory on the host computer or the remote storage device;

b. a connector operable to connect the memory to a host computer (column 2, line 63-column 3, line 1, column 3, lines 46-48, "logical connections" and column 3, line 59-column 4, line 6);

c. a processor to: run an original operating system for the host computer; (column 4, lines 11-15) and execute the set of instructions to create the emulated environment (column 4, lines 18-22).

13. As to Claim 2, Lew teaches a Universal Serial Bus as an input to the host computer. (column 3, line 41). Therefore, a Universal Serial Bus Cable is used as a connector between the host device and the memory.

14. As to Claim 3, Lew teaches that input devices are often connected to the processor of the host computer by a serial port interface (column 3, lines 36-38). The serial port interface encompasses the use of an IEEE-1394 cable since it is a serial bus used for data transfer.

15. As to Claim 4 and 6, Lew teaches that wireless signals can be used to connect the host computer and the memory (column 4, lines 4-5). The use of wireless signals with a

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network adapter and/or modem encompass the use of an infrared or wireless link in accordance with 802.11b.

16. As to Claim 5, Lew teaches the connection of the host computer and memory as a LAN or WAN (column 3 lines 54-65) networking environment using a modem or "other means for establishing communications over a network". It is well known in the art that Ethernet cables are used for network connections between computers in a LAN or WAN environment.

17. As to Claim 7, Lew teaches the host computer is personal computer compatible (column 2, line 45).

18. As to Claim 8, Lew teaches the host computer is Macintosh compatible (column 2, line 45). It is concluded that the statement "other environments are possible" includes the possibility that the host computer can be Macintosh compatible.

19. As to Claim 10, Lew teaches the at least one set of instructions in memory further comprises multiple sets of instructions for several different processors (column 4, lines 48-52) wherein the instructions are the modules for several different processors, for example, native, 80386 or 80486 processors.

21. As to Claim 11, Lew teaches: connecting an emulation system having a memory device to a host computer having an original operating system (column 4, lines 18-26)

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wherein the emulation program, 211, may find physical form an indicia recorded on a storage medium (memory) such as the hard drive, diskette or optical disk, which are connected to the memory of the host computer by the system bus (Figure 1, elements 23,32-34); using the original operating system to load a set of instructions from the memory device to the host computer (column 4, lines 27-31); executing the set of instructions to establish an emulated operating environment on the host computer (column 4, lines 57-59).

22. As to Claim 12, Lew teaches user input designating the set of instructions to be loaded from the memory device 9 (column 3, lines 32-34). It is concluded that the user input can choose an application to be from the remote storage device, designating the set of instructions to be loaded from memory based on the application choose.

23. As to Claim 13, Lew teaches selecting a set of instructions automatically wherein the set of instructions are made by the host computer (column 4, lines 31-36). It is concluded that when the host computer determines the operating environment to be simulated, it automatically loads the external modules necessary for execution.

24. As to Claim 14, Lew teaches wherein connecting the emulation system to the host computer further comprises connecting the emulation system to an accessory device (column 3, line 46-column 4, line 6) wherein the emulation system resides on the host



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computer and the host computer is connected to an accessory device, therefore, the emulation system is connected to the accessory device.

25. As to Claim 20, Lew teaches:

connecting an emulation system having a memory device to a host computer having an original operating system (column 4, lines 18-26) wherein the emulation program, 21 1, may find physical form an indicia recorded on a storage medium (memory) such as the hard drive, diskette or optical disk, which are connected to the memory of the host computer by the system bus (Figure 1, elements 23,32-34); using the original operating system to load a set pf instructions from the memory device to the host computer (column 4, lines 27-31); executing the set of instructions under the original operating system (column 4, lines 57-59) to establish the memory device of the emulation system as an external memory device for the host computer (column 3, line 65-column 4, line 1).

26. Claims 15-19 are rejected under 35 U.S.C. 103 (a) as obvious by Shaheen et al. (U.S. Patent 5,893,920 (1999)), in view Gaines (U.S. Patent 5,961,582 (1999)).

Shaheen et al. teaches a system and method for cache management in mobile user file systems (title) by way of a first computer system which disables from said second file system when necessary (columns 8-9, lines 67-68 and 1-8, respectively) but doesn't teach host computer emulation. Gains teaches a method on insulating an operating environment emulator from a host computer.

It would have been obvious, at the time of invention, to one of ordinary skill in the art to modify Shaheen et al. by Gains to preserve files with updates that need to be synchronized back to the server (Shaheen: column 3, lines 36-39) during the emulation process.

27. As to Claim 15, Gaines teaches: a method of insulating an operating environment emulator from a host computer, the method comprising: a) blocking host task managing applications for an original operating system on the host computer (column 6, lines 47-55, column 9, lines 64-67) wherein the host refuses to perform the service; b) routing all inputs through the emulated operating system (column 7, lines 1-4, column 8, lines 43-48, column 9, lines 64-67); and by Shaheen, teaches: disabling a second file system (column 9, lines 5-9);

e) activating an environmental shutdown if necessary to prevent interactions between the original operating system and the emulated operating system (column 7, lines 8-14) wherein the host refuses to perform the task requested by the emulated operating system.

28. As to Claim 16, Gaines teaches: wherein blocking host task managing applications further comprises a complete block (column 7, lines 8-14) wherein the user's request is denied if it violates access permissions and the host system does not perform the service.

29. As to Claim 17, Gaines teaches: wherein blocking task managing applications further comprises a partial block (column 7, lines 4-8) wherein the user's request is

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implemented only if it does not violate the access permissions, therefore, some of the requests from the emulated operating system are performed.

30. As to Claim 18, Gaines teaches: wherein the interactions further comprise any interaction (column 7, lines 1-14) wherein any interaction is the ("request for service").

31. As to Claim 19, Gaines teaches: wherein the interactions further comprise interactions selected by a user (column 8, lines 43-48).

31. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lew as applied to Claim 1 above, and further in view of Gaines.

32. As to Claim 9, Lew teaches: at least one set of instructions for an emulated operating environment stored in memory (column 3, line 66-column 4, line 1, column 4, lines 18-26, 33-36).

33. Lew does not expressly teach the at least one set of instructions in the memory further comprises multiple sets of instructions for several different operating systems.

34. Gaines teaches at least one set of instructions in the memory further comprises multiple sets of instructions for several different operating systems (column 5, lines 4-18, 48-50) wherein the different operating systems are the host virtual operating system and the host operating system. Furthermore, the host virtual operating system can be programmed to include instructions for a plurality of operating systems.

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the set of instructions in memory as taught in Lew to include instructions for different operating systems as taught by Gaines (column 5, lines

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4-18, 48-50) since both Lew and Gaines are directed to emulating an operating environment on a host or native operating system.

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is 571-272-3715, Monday-Friday (8:00 am- 4:30 pm) or contact Supervisor Mr. Kevin Teska at (571) 272-3716. Fax number is 571-273-3715.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

April 11, 2005



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THS